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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,678	08/22/2003	Peter Wilding	1070-PENN-E890-CON5	1013
110	7590	06/22/2004	EXAMINER	
DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307			CHIN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/646,678	Applicant(s) WILDING ET AL.	
	Examiner Christopher L. Chin	Art Unit 1641	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. Claim 82 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 82 is vague and indefinite because it is not clear as to what constitutes a "few millimeters thick". The metes and bounds of the claim cannot be determined.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-29 of U. S. Patent No. 5,296,375 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: U.S. Patent '375 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 6, lines 31-44, of patent '375 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '375 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,304,487 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '487 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 6, lines 8-20, of patent '487 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '487 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-2 of U. S. Patent No. 5,427,946 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '946 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 6, lines 38-50, of patent '946 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '946 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-25 of U. S. Patent No. 5,486,335 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '335 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 6, lines 25-45, of patent '335 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '335 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-20 and 25-27 of U. S. Patent No. 5,498,392 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '392 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 8, lines 40-49, of patent '392 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '392 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-36 of U. S. Patent No. 5,587,128 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '128 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 14, lines 50-61, of patent '128 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '128 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-28 of U. S. Patent No. 5,726,026 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '026 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 8, lines 44-47, of patent '026 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '026 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

10. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claim 13 of U. S. Patent No. 5,744,366 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '366 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of



the instant application. For example, column 9, lines 49-67, of patent '366 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '366 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-4 and 8 of U. S. Patent No. 5,955,029 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '029 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 8, lines 40-49, of patent '029 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '029 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

12. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 6,660,517 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '517 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 14, lines 52-64, of patent '517 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '517 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

13. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-20 and 30-40 of U. S. Patent No. 5,637,469 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '469 also claims a mesoscale fluid

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handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 7, lines 37-50, of patent '469 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '469 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

14. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 5,866,345 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '345 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 7, lines 38-51, of patent '345 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '345 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

15. Claims 43-94 are rejected under the judicially created doctrine of double patenting over claims 1-52 of U. S. Patent No. 6,551,841 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: U.S. Patent '841 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, column 7, lines 37-50, of patent '841 disclose claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '841 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

16. Claims 43-94 are provisionally rejected under the judicially created doctrine of double patenting over claims 43-78 of copending Application No. 10/348,438. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: copending 10/348,438 also claims a mesoscale fluid handling device and its specification discloses the limitations recited in claims 43-78 of the instant application. For example, page 17 of the '678 application discloses claim 43 of the instant application. The limitations recited in claims 44-94 can be found throughout the specification of the '438 application

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Chin whose telephone number is (571) 272-0815. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher L. Chin  
Primary Examiner  
Art Unit 1641

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